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In re Application of :
James G. Keck et al :
Serial No.: 09/601,997 : PETITION DECISION
Filed: December 15, 2000 :
Attorney Docket No.: 24743-2307US :

This is in response to the petition under 37 CFR 1.181, filed May 15, 2007, requesting reconsideration of the previous petition decision to withdraw of the Finality of the Office action mailed March 26, 2007.

BACKGROUND

A review of the extensive file history is summarized as follows:

December 15, 2000, Application accepted as National Stage entry of PCT/US98/27942;
September 26, 2002, Restriction requirement mailed;
October 25, 2002, Applicant files response electing Group II;
January 9, 2003, First Office action on merits mailed;
May 7, 2003, Response to Office action;
July 25, 2003, Final Office action mailed;
January 26, 2004, RCE papers filed with amendment;
April 20, 2004, New Office action mailed;
October 25, 2004, Reply to Office action;
February 3, 2005, Non-Final Office action mailed;
August 3, 2005, Response filed by applicants;
October 20, 2005, Final Office action mailed;
April 20, 2006, Amendment After Final filed and Notice of Appeal;
May 22, 2006, Advisory Action mailed;
September 20, 2006, Second Amendment After Final following examiner interview filed;
October 16, 2006, New Final Office action mailed;
October 30, 2006, First Petition filed alleging new ground of rejection making action improper;
December 20, 2006, Petition Decision mailed withdrawing Office action as incomplete;
January 16, 2007, Renewed Petition requesting finality be withdrawn;
March 16, 2007, Petition Decision mailed affirming Office action withdrawn.

Following the last Petition Decision the examiner mailed applicant a new complete Office action on March 26, 2007, which was made Final. Applicants now petition the finality of that Office action.

DISCUSSION

Applicants request that withdrawal of the finality of the Office action of March 26, 2007, be granted based on the fact that a new ground of rejection was raised in the Office action that was not necessitated by applicants' amendments filed September 20, 2006..

The previous petition decisions noted that the Office action mailed October 18, 2006, was, as stated by the examiner, incomplete as some art rejections were not maintained due to indefiniteness in the claims. In view of the incompleteness the Office action of October 18, 2006, it was withdrawn and the application was returned to the examiner with the direction to prepare of a new Office action. No decision as to the propriety of the Finality of the Office action of October 18, 2006, was set forth, however the examiner was directed to consider applicants arguments in each of the petitions in preparing a new Office action. Having considered the petition decisions the examiner mailed a new Final Office action to applicants.

Applicants continue to argue that the Office action sets forth a new ground of rejection not necessitated by applicants' amendments. The rejection in question is under 35 U.S.C. 112, second paragraph, for indefiniteness and states that, *inter alia*, that the claim is incomplete in that it lacks mention of a control un-transfected host cell. This is the only part of the rejection objected to as being a new rejection. All other parts of the rejection had been previously set forth in previous Office actions for the same reasons as set forth now.

It is noted that applicants have been on notice regarding this rejection since at least October, 2006, and have not filed any arguments or amendments to overcome it. Although the Office action of October 18, 2006, was formally withdrawn as being an incomplete action in view of a statement by the examiner, and no response to the Office action was required, as noted in the first petition decision, there was also no prohibition against applicants filing an amendment or argument against this proposed rejection. Applicants have had ample opportunity to address this rejection prior to the examiner's new Office action.

The examiner specifically states that the petition decisions have been considered as well as applicants' amendments filed September 20, 2006, and January 16, 2007. The examiner has now mailed a Final Office action to applicants with the intent of seeking to draw prosecution of this application to a close in an expeditious manner. In view of the examiner's statements and considerations, the finality will not be withdrawn.

DECISION

The petition is **DENIED**.

Applicants remain under obligation to take appropriate action in response to the Final Office action mailed March 26, 2007.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Christopher Low

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(acting)